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OFFICE OF PETITIONS

In re Application of
Neev
Application No. 09/854,311
Filed: May 10, 2001
For: OPTO-THERMAL MATERIAL
MODIFICATION

NOTICE TO FILE CORRECTED
APPLICATION PAPERS

The above-identified application was filed on May 10, 2001 and claims the benefit of provisional applications 60/272, 653 filed on February 28, 2001, and 60/237,548, filed on September 30, 2000, and 60/215,657 filed on July 1, 2000, and 60/203,647 filed on May 12, 2000. A copy of the specifications (including claims) and drawings, of at least one of the prior applications along with other sets of application papers was deposited as the application papers for the above-identified application. The application papers include a specification or parts of a specification entitled "Opto-Thermal Material Modification", "Enhancement of Substance Delivery", and "A Method and Device for Medicated Material Modification and Conditioning - ISM III".

An application number and filing date have been assigned to the above-identified application. The application papers are not in condition for publication. Applicant is given TWO MONTHS FROM THE DATE OF THIS NOTICE within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). Any additional claim fees under 37 CFR 1.16 must also be paid.

The following item is required in response to this notice:

(1) A substitute specification including a single specification, with one brief description of the drawings for figures 1- ### in consecutive Arabic numerals, starting with 1, not skipping to 1.1, 1.2, 1.2.1 or Fig 1A, Fig, 1B, and with one of each element set forth in 37 CFR 1.77. See 37 CFR 1.84 and 1.121(b)(3). The substitute specification filed in response to this notice should not include any claims in the middle of the specification and must include a clean set of claims.

The substitute specification filed under 37 CFR 1.125 must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. The substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

The application papers for the above-identified application include: three specifications on pages 1-107; six sets of claims: claims 6-9 in the middle of the specification on page 23, claims 1-14 in the middle of the specification on pages 23-25, claim 1 in the middle of the specification on pages 25-26, claims 1-21 in the middle of the specification on pages 27-31, claims 1-143 in the middle of the specification on pages 76-100 and claims 1-20 on pages 106-107; three title pages: the title on page 1 is "Opto-Thermal Material Modification", the title on page 27 is "Enhancement of Substance Delivery", and the title on the page 34 is "A Method and Device for Medicated Material Modification and Conditioning - ISM III"; two abstracts on pages 27 and 104, now amended on page 108; two brief descriptions of drawings on pages 3-4 which include descriptions for figures 1-9, and pages 46-49 which include descriptions for figures 1.1, 1.2, 1.2.1, 1.2.2, 1.3, 1.4 . . . 1A, 1B, 1C . . . - 8.

By submitting a copy of the prior applications or parts of applications as the application papers for the above-identified application, applicants are causing an unreasonable burden on the Office in publishing the application and delays in the processing and examination of the application. The specification of the application does not comply with 37 CFR 1.77 in that three or more versions of each section were included. If the application papers that were originally filed were to be published, the resulting document would be very confusing as it would appear that the Office made a mistake in publishing three or more different applications as a single application.

On January 25, 2002, applicant filed a preliminary amendment in response to the Notice to File Corrected Application Papers, which included a copy of claims 1-20 on pages 106-107 commencing on a separate page to replace original claims 1-20 appearing on pages 106-107 of the application as originally filed. However the preliminary amendment also included instructions for the Office to delete Claims 6-9 on page 23 and insert after Claim 5 on page 106, which leads to confusion as to what claim set applicant is in the application.

The preliminary amendment filed on August 23, 2001, may introduce new matter into the specification, as it makes reference to four (4) earlier filed provisional applications and incorporates them by reference. The specification as originally filed only makes reference to provisional application 60/203, 647 filed on May 12, 2000 and incorporates it by reference. The incorporation by reference statement makes the specification of the other three provisional applications part of the instant application, which may constitute new matter. See MPEP 608.01(p) and 608.04(a).

The thirty-one (31) pages of drawings filed on May 10, 2001 are noted. The drawings begin with Fig. 100A and conclude with Fig. 7F. However, there is no brief description of figures 100A, 101A, 103A, 104A and 105A. The substitute specification should include one brief description of the drawings for figures 1-### and one detailed description of the drawings for figures 1-###.

Further correspondence with respect to this matter should be addressed as follows:

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